



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,538	09/12/2003	Tsutomu Ohishi	242738US2	5339
22850	7590	07/30/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
RODRIGUEZ, LENNIN R				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
07/30/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/660,538

Applicant(s)

OHISHI ET AL.

Examiner

LENNIN R. RODRIGUEZ

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-16, 18-26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-16, 18-26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date 5/06/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 14 and 28 have been considered but are moot in view of the new ground(s) of rejection.
2. Drawings objections of items 1-2 have been withdrawn in view of the submitted amendment.
3. Drawings objections regarding drawing objections item 3[(1)-(2)] are sustained, due to the fact that even though the reference numbers are being discussed in other drawings, the area of the specification, in this case pages 17 and 42-43, are being referred specifically to drawings 3 and 17 respectively and in this 2 drawings this reference numbers are not shown.
4. Specifications objections have been withdrawn in view of the submitted amendment.
5. Rejection under 35 U.S.C. 101 has been withdrawn in view of the submitted amendment.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 14 and 28 rejected under 35 U.S.C. 102(e) as being anticipated by Whitmarsh (US 2002/0101608).

(1) regarding claims 1, 14 and 28:

Whitmarsh '608 discloses an image forming apparatus (10 in Fig. 1) comprising:
an information providing part (workflow application server 14 in Fig. 1) configured to function as a Web server (paragraph [0021], lines 11-23), the information providing part configured to provide, to a client terminal, screen data to be displayed as a Web screen by a Web browser on the client terminal (paragraph [0004], lines 15-19 and paragraph [0030], lines 1-4, where a web pages are being used), the screen data being used for selecting one or more image forming apparatuses among from a plurality of image forming apparatuses (paragraph [0035] and paragraph [0036], lines 1-4, where the user can select the destination printer among the ones shown in a list) connected to a network (paragraph [0021], lines 1-7, where the printers are connected through a network to the system); and

a print request part for distributing print data and a print request to the selected one or more image forming apparatuses (18 in Fig. 1) selected on the Web screen (paragraph [0046], lines 1-7).

(2) regarding claims 2 and 15:

Whitmarsh '608 further discloses wherein the information providing part sends screen data for inputting a print instruction to the client terminal (paragraph [0041]-

[0042], where via a browser there is provided a screen so that the user can make choices); and

the print request part distributes the print data and the print request when receiving the print instruction from the client terminal (paragraph [0046], lines 1-7).

(3) regarding claims 3 and 16:

Whitmarsh '608 further discloses wherein the information providing part sends screen data used for uploading the print data to the client terminal (paragraph [0038]); and

the image forming apparatus receives the print data when the print data is uploaded from the client terminal (paragraphs [0038]-[0039]).

(4) regarding claims 5 and 18:

Whitmarsh '608 further discloses wherein the screen data includes data for displaying a plurality of image forming apparatuses (paragraph [0043], where the user can select the destination printer among the ones shown in a list) and corresponding places for each of the image forming apparatuses (paragraph [0043], where the list includes publisher address).

(5) regarding claims 6 and 19:

Ohara '179 further discloses wherein the screen data includes data for displaying a plurality of image forming apparatuses (paragraph [0043], where the user can select the destination printer among the ones shown in a list) and corresponding functions for each of the image forming apparatuses (paragraph [0041]).

(6) regarding claims 8 and 21:

Whitmarsh '608 further discloses wherein the print instruction includes an instruction for designating functions to be used for printing the print data (paragraph [0041]-[0042], where via a browser there is provided a screen so that the user can make choices), and

the print request part selects one or more image forming apparatuses that includes the designated functions from among the selected one or more image forming apparatuses (paragraph [0043], where the user can select the destination printer among the ones shown in a list), and distributes the print data and the print request to the one or more image forming apparatuses that includes the designated functions (paragraph [0046], lines 1-7).

(7) regarding claims 11 and 24:

Whitmarsh '608 further discloses further comprising an address obtaining part for obtaining addresses of image forming apparatuses connected to a network (paragraph [0043], where the list includes publisher address); and

wherein the print request part distributes the print data and the print request by using addresses obtained by the address obtaining part (paragraphs [0044] and [0046], where the user selects an address).

(8) regarding claims 13 and 26:

Whitmarsh '608 further discloses the image forming apparatus further comprising hardware resources used for image forming processes (Fig. 1, where it has a variety of hardware components), and control services that perform processes of the system side

including control of the hardware resources according to a request from an application executed in the image forming apparatus (14 in Fig. 1),

wherein the image forming apparatus is configured to be able to install a plurality of applications separately from the control services (paragraph [0033], where different programs such as job store application can be installed), and the image forming apparatus includes the information providing part and the print request part as an application (paragraph [0043]).

8. Claims 7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitmarsh (US 2002/0101608) in view of Kato (US 6,141,111).

(1) regarding claims 7 and 20:

Whitmarsh '608 further discloses wherein the print request part distributes the print data and the print request by referring to the information stored in the storing part (paragraph [0047], where the repository is being interpreted as the storing part).

Whitmarsh '608 discloses all the subject matter as described above except the image forming apparatus further comprising a storing part for storing information including addresses of the selected one or more image forming apparatuses.

However, Kato '111 teaches the image forming apparatus further comprising a storing part for storing information including addresses of the selected one or more image forming apparatuses (column 4, lines 36-43, where the network address of the apparatuses are being stored).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the image forming apparatus further comprising a

storing part for storing information including addresses of the selected one or more image forming apparatuses as taught by Kato '111 in the system of Whitmarsh '608. With this the system has absolute knowledge of which address to use when trying to control the devices that are connected apart from the forming apparatus itself, thus making the system increase the reliability.

9. Claims 9-10 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitmarsh (US 2002/0101608) in view of Shima (JP 2001209503 A, machine translation it's being used for the citations).

(1) regarding claims 9 and 22:

Whitmarsh '608 discloses all the subject matter as described above except wherein the print request part requests a printing part of the image forming apparatus itself to print the print data.

However, Shima '503 teaches wherein the print request part requests a printing part of the image forming apparatus itself to print the print data (paragraph [0009], where with the loop back address the system is able to perform this function).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made wherein the print request part requests a printing part of the image forming apparatus itself to print the print data as taught by Shima '503, in the system of Whitmarsh '608. With this the development cost are reduced by dispensing with the development of an interface relying on each printing server (English abstract).

(2) regarding claims 10 and 23:

Whitmarsh '608 discloses all the subject matter as described above except wherein the print request part requests the printing part of the image forming apparatus itself to print the print data by using a loop back address.

However, Shima '503 teaches wherein the print request part requests the printing part of the image forming apparatus itself to print the print data by using a loop back address (paragraph [0009], where with the loop back address the system is able to perform this function).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made wherein the print request part requests the printing part of the image forming apparatus itself to print the print data by using a loop back address as taught by Shima '503, in the system of Whitmarsh '608. With this the development cost are reduced by dispensing with the development of an interface relying on each printing server (English abstract).

10. Claims 12 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitmarsh (US 2002/0101608) in view of Aoyagi et al. (US 2002/0032761).

Whitmarsh '608 discloses all the subject matter as described above except wherein the address obtaining part obtains the addresses from MIBs by using SNMP.

However, Aoyagi '761 teaches wherein the address obtaining part obtains the addresses from MIBs by using SNMP (paragraph [0393]).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made wherein the address obtaining part obtains the addresses from MIBs by using SNMP as taught by Aoyagi '761, in the system of Whitmarsh '608. This

allows for displaying a network configuration chart that allows easy understanding of port-by-port connections of network devices and the like (paragraph [0013]).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **LENNIN R. RODRIGUEZ** whose telephone number is (571)270-1678. The examiner can normally be reached on Monday - Thursday 7:30am - 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

/Lennin R Rodriguez/
Examiner, Art Unit 2625